A) Gr up VI should additionally include claims 2-9, and 18-21:

Elected Group VI should additionally include claims 2-9, and 18-21. Claims 2-3 pertain to the use of controls, claims 4-9 pertain to the cell that is screened, and claims 18-21 pertain to the test agent(s) that are screened. These claims depend from claim 1, which is within the elected Group VI and they are not limiting with respect to the screening target or to the moiety screened (*e.g.* VGLUT3 protein). These claims are in effect generic with respect to the presently elected group and can and should be included in Group VI as well as Group I. **If the Examiner wishes to maintain this restriction Applicants request that the Examiner identify with specificity his reasoning for including claims 2-9 in Group I as opposed to Group VI.**

B There is no basis for the existence of the Groups of Set 4 in the restriction requirement.

The restriction of the Groups of set IV (Groups XXVIII, XXIX, XXX, XXXI, XXXII) is improper. All five groups comprising this set are drawn to claims 1-10, 13-15, 18-23, and 38-47. There is no difference between these groups.

In addition, contrary to the Examiner's assertion, claims **1-10, 13-15, and 18-23 are not drawn to a method of increasing or inhibiting glutamate uptake in a cell.** Claim 1 expressly recites:

> 1. **A method of screening for an agent** that modulates the uptake of glutamate into a cell, said method comprising . . .

Claims 1-23 are not directed to method of increasing or inhibiting glutamate **uptake in a cell.** The Examiner is simply incorrect in his assertion and consequently there is no basis for the existence of the Groups of Set 4.

C) The restriction between Groups I, IV, VII, II, V, VIIII, III, VI, IX, XXVIII, XXIX, XXX, XXXI, and XXXII is legally improper.

The restriction claim I into fourteen different Groups is legally improper. Rather, the Examiner should have imposed an election of species.

In making such a restriction, the Examiner effectively requires that a single claim (*e.g.*, claim 1) be divided up and presented in several applications (*i.e.* the Examiner effectively

requests that claim 1 be divided up and presented in 14 different applications). This flatly contravenes accepted law. As stated by the CCPA:

> As a general proposition, an applicant has a right to have ***each claim*** examined on the merits.
>
> * * *
>
> If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.
>
> * * *
>
> §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions, ... It does not provide a basis under the authority of the Commissioner to *reject* a particular *claim* on that same basis.
>
> * * *
>
> We hold that a rejection under §121 violates the basic right of the applicant to claim his invention as he chooses. *In Re Weber, Soder and Boksay* 198 USPQ 328, 331-332 (CCPA 1978)

See also, *In Re Haas* 179 USPQ 623, 624, 625 (*In Re Haas I*) and *In Re Haas* 198 USPQ 334-337 (*In Re* Haas *II*).

The CCPA thus recognized that an Examiner **may not** reject a particular claim on the basis that it represents "independent and distinct" inventions. *See, In re Weber Soder and Boksay, supra.* Moreover, **the CCPA recognized that imposition of a restriction requirement on a single claim is just such an improper rejection.**

In particular, the courts have definitively ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. §121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In Re Weber, Soder and Boksay, In Re Haas I, and In Re Haas II.* More specifically, the CCPA expressly

ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *Weber*:

> The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- **no matter how broad, which means no matter how many independently patentable inventions may fall within it**. [emphasis added] *In Re Weber* at 334.

Applicants recognize that instead of improperly imposing a restriction requirement on a single claim, the Office may limit initial examination to a "reasonable number" of species encompassed by the claim. *See*, 37 C.F.R. §1.146. This practice strikes an appropriate balance between the concerns of the patent office regarding administrative concerns and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. §112 are complied with. *See*, *e.g.*, the MPEP at 803.02, *In Re Wolfrum* 179 USPQ 620 (CCPA, 1973) and *In re Kuehl* 177 USPQ 250 (CCPA, 1973).

Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications that are incapable of capturing the intended scope of the application. It should be clear that the added cost of filing and prosecuting 14 divisional patent applications (for claim 1 alone) and 32 different patent applications for the entire application **does not** strike an appropriate balance between the administrative concerns of the office and Applicants statutory rights as inventors.

Finally, Applicants note that the CCPA has explicitly held that improper restriction of a single claim is a decision under the jurisdiction of the Board of Appeals, and the Federal Courts. This is in contrast to simple administrative decisions regarding ordinary restriction requirements, which are not generally subject to Appellate review. *See, In Re Haas I, supra.* Because restriction of a single claim into multiple groups is tantamount to a rejection and a refusal to examine the claim as drafted, as articulated in *Haas I*, the Board of Appeals and the courts have jurisdiction over the decision. Accordingly, **Applicants expressly reserve the right to appeal any decision that may be made regarding the present response to the Patent Office Board of Appeals and to the Federal Circuit**.

In view of the foregoing, Applicants respectfully request that the above identified restriction requirements be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3513.

QUINE INTELLECTUAL PROPERTY LAW
GROUP, P.C.
P.O. BOX 458
Alameda, CA 94501
Tel: 510 337-7871
Fax: 510 337-7877

Respectfully submitted,

Tom Hunter
Reg. No: 38,498

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